

## REMARKS/ARGUMENTS

### *Status of the Application*

In the Final Office Action, claims 1-6, 8-10, and 12-13 were rejected. In the present response, no amendments to the claims were made. Thus, claims 1-6, 8-10, and 12-13 are pending. No new matter was added.

### *Rejections Under 35 U.S.C. § 112, First Paragraph*

Claims 1-6, 8-10, and 12-13 were rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse these rejections.

The Examiner asserted that the amending of the word “comprising” to “consisting of” in claim 1 constituted new matter. The Examiner, however, provides no citations of caselaw or from the MPEP for this novel proposition. In essence, the Examiner asserts that the transitional phrase “comprising” must *always* contain more than claimed, and cannot only contain the elements set forth after the transition. Applicants, however, only find support for the principle that the term “comprising” *may* contain additional elements not specifically listed in the claim, not that “comprising” must contain additional elements. *See, e.g., Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements *may* be added and still form a construct within the scope of the claim.”) (emphasis added). Applicants have found no case stating that “comprising” *must* be open-ended, and the Applicants invite the Examiner to supply such a decision.

Patent applicants use the word “comprising” under the assumption that an amendment to “consisting essentially of” or “consisting of” might be required to gain allowance of a claim. Indeed, the Board of Patent Appeals and Interferences has recognized that

[i]t is well settled that the terms ‘comprising’ and ‘containing’ do not exclude the presence of other ingredients than the one or ones recited, and that a claim reciting those ingredients can properly be rejected on a reference disclosing them and additional ingredients. It is also known that an applicant seeking to restrict his claims may use the very limiting term ‘consisting of’ or the terms of intermediate scope, ‘comprising essentially’, or ‘consisting essentially of’.

*In re Muench*, 79 U.S.P.Q. (BNA) 92, 93 (B.P.A.I. 1948) (internal citations omitted). Patent examiners also have utilized the narrower transition phrases when proposing amendments to gain allowance of claims. See, e.g., *Momentum Golf, Inc. v. Swingrite Golf Corp.*, 312 F. Supp. 2d 1134, 1140 (S.D. Iowa 2004) (noting that the examiner's suggested amendments replaced the transition term "comprising" with "consisting essentially of" to avoid anticipatory prior art). Here, the Examiner's rejection of Applicants' claims using this novel new matter rejection is an apparent change in USPTO policy contrary to years of established practice. Applicants had no notice of such a change in USPTO policy and, furthermore, do not believe that such a change can be implemented without notice thereof.

While Applicants understand that the USPTO is not involved in infringement actions, an illustration utilizing infringement reveals the unreasonableness of this rejection. Consider an accused process that consists only of the steps enumerated in claim 1. Under the Examiner's analysis, this accused process would *not* infringe claim 1 with "comprising" as the transitional phrase because the accused process does not contain additional elements. This cannot be correct. An accused process that reads exactly on the claim limitations is the essence of literal infringement. Any other result eviscerates the function of the claims, that is, as a measure of the metes and bounds of a patentee's right to exclude.

Applicants respectfully submit that the proper inquiry under a written description analysis is whether one of ordinary skill in the art would recognize that the applicant possessed the invention at the time the patent application was filed. MPEP § 2163.02. There can be no dispute here that one of ordinary skill in the art would recognize that Applicants possessed the present claim 1 invention in light of the disclosure of the invention using "comprising" as a transition phrase and the disclosure of a working embodiment that contains all of the current claim limitations. *Cf. In re Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973) ("The alternative [of unnecessary disclosure] places . . . the undue burden of listing, in the case of applicants, reading and examining, in the case of the Patent Office, and printing and storing, in the case of the public, descriptions of the very many structural and functional equivalents of disclosed elements or steps which are already stored in the

minds of those skilled in the arts.”). Consequently, Applicants respectfully submit that the section 112, 1<sup>st</sup> paragraph, rejection is improper and should be withdrawn.

***Rejections Under 35 U.S.C. § 102(b)***

Claims 1-2, 5-6, 8-10, and 12-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by George *et al.* (U.S. Patent No. 4,061,516). Claims 1-3, 5, 8-10, and 12-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by WO 95/02461. Applicants respectfully traverse these rejections.

The Examiner’s anticipation rejections rely on the new matter rejection traversed above, namely, that George *et al.* anticipates claims 1-2, 5-6, 8-10, and 12-13 or that WO 95/02461 anticipates claims 1-3, 5, 8-10, and 12-13 when claim 1 has “comprising” as a transition phrase. Because the new matter rejection has been traversed above, Applicants respectfully submit that the novelty arguments submitted in the August 26, 2005, Response to Non-Final Office Action apply.

***Rejections Under 35 U.S.C. § 103(a)***


Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over George *et al.* Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 95/02461. Applicants respectfully traverse this rejection.

The Examiner’s patentability rejections rely on the new matter rejection traversed above, namely, that claims 3 and 4 are unpatentable over George *et al.* or that claim 4 is unpatentable over WO 95/02461 when claim 1 has “comprising” as a transition phrase. Because the new matter rejection has been traversed above, Applicants respectfully submit that the patentability arguments submitted in the August 26, 2005, Response to Non-Final Office Action apply.

**Summary**

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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